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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,984	03/27/2006	Mark Anderson	40735034/54567US	6592

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Intellectual Property Dept.
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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

NOTIFICATION DATE	DELIVERY MODE
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07/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-ip@dewittross.com

Office Action Summary	Application No. 10/559,984	Applicant(s) ANDERSON, MARK	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/9/05 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,27-39 and 42-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,10-12,16-20,22-25,27-35,37-39,42 and 44-51 is/are rejected.
- 7) ☒ Claim(s) 7-9,13-15,21,36 and 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the first action relating to U.S. Application Serial No. 10/559,984 filed on December 9, 2005.

5

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

10

Preliminary Amendment

3. Receipt is acknowledged of the preliminary amendment filed on December 09, 2005. Currently claims 1-25, 27-39, and 42-51 remain in the examination.

Claim Objections

15

4. Claim 10, 27, 28, 36, and 45 are objected to because of the following informalities:

Re claim 10, line 2: substitute "proximity connector" with --proximity conductor-- as recited in claim 1. See claim 1, line 4.

20

Although this claim is objected, appropriate correction must be made to avoid lack of antecedent basis problem.

Re claim 27, line 2: substitute "organisational" with --organizational--.

Re claim 28, line 1: substitute "organisational" with --organizational--.

Re claim 45, line 2: substitute "organisational" with --organizational--.

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Re claim 36, lines 2 and 4, please substitute "it" and "their" with what they actually represent. For example, if "it" were the waveguide, use "the waveguide," or "said waveguide." Applicant is respectfully suggested to review all claims and substitute pronouns in the claims with what they represent.

5 Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15 Regarding claim 6, line 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

7. Claims 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite
20 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 19, in order to communicate, the proximity conductor has to be within range. How is it able to receive transmission farther than the range? Isn't it within the range by definition? It is unclear what is being claimed in this claim.

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8. Claims 22, 28, 30, 38, 39, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 22, it is unclear what Applicant meant by "trusted" remote visual display
5 device.

Re claim 28, line 2, it is unclear what Applicant meant by "restricted to being a [sic] one-off process." Claim 30 is rejected on the same basis as claim 28.

Re claim 38, line 1, 3, 4, it is unclear what Applicant meant by "trusted" and "untrusted."

10 Re claim 39, is "the display" refereeing to "trusted light display" (claim 38, line 3) or "a trusted display" (claim 38, line 4)? Also, if the display in claim 39 is untrusted, and both display devices in 39 are trusted, claim 39 and 38 are contradictory. If claim 38 is true, claim 39 is not. Or, vice versa.

Re claim 42, it is unclear what Applicant meant by "trusted alpha-numeric
15 display."

Applicant is required to clarify the following phrases used in the claims, "one-off", "untrusted", and "trusted." The claims listed here may not be exhaustive list of the claims containing these phrases.

20 9. Claims 25, 34, and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Re claim 25, it appears that claim 25 is an independent claim reciting a method. However, it appears that claim may be construed to be a dependent claim of claim 1. Please substitute the text for [claim 1] in line 2.

Claims 34 and 44 are rejected on the same ground as claim 25.

5

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such
15 treaty in the English language.

11. Claims 1- 6, 10-12, 17-19, 22-25, 27-35, 37, and 44-51 are rejected under 35 U.S.C. 102(e) as being anticipated by US 7,303,120 B2 to Beenau et al. (hereinafter
20 "Beenau").

Re claims 1, 5, 19, 24, and 44, Beenau discloses a credential communication device 102 adapted to transmit and receive data as indicated with arrows with a second credential communication device 104 (see figure 1). The communication device 102 is comprised of a proximity conductor 202 which is used in transmitting and receiving the
25 data (col. 9, lines 25+). The transponders and readers use designated frequencies (col. 4, lines 11-12) and they operate in a proximity, which would exclude third party involvement in the transmission or reception of data (col. 4, lines 15-21). Contactless communication is by inductive means.

Re claim 2, relying on figure 6A, the authentication step 604 is a first step before any transaction.

Re claim 3, Beenau further discloses that the device is comprised of a keyboard (col. 17, line 62) for the user to enter personal information such as PIN.

5 Re claims 4 and 17, the device may include biometric sensor 904 (see figure 5, and col. 12, lines 4+) and authenticating circuit 210.

Re claim 6, the proximity between the two devices includes contact.

Re claim 10, the communication device may be a tag, fob, or card (col. 4, lines 15-20). In case of a conventional card, the card is layered with polycarbonate material to
10 protect the card and provide rigidity for the card.

Re claim 11, relying on figure 9, authentication circuit is a means to effect credential verification.

Re claim 12, the device is comprised of a blinking indicator (col. 50, lines 18+) to alert the user.

15 Re claim 18, the biometric sensor is a fingerprint sensor (col. 12, lines 3-14).

Re claims 22, 23, and 37, the reader may be a remote device (col. 8, lines 24+). Since the fob can be used as an identification means (col. 2, lines 17+), it can be used as badge or other identifying means.

Re claim 25, Beenau also discloses a method and system for the transponder and
20 reader (see abstract). The methods are illustrated in figures 4-8.

Re claims 27, 28, 31, 32, and 45-48, activating the device properly so that the device would respond to only designated signals (col. 2, lines 57-67) which is mandatory

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for the device to function. To an extent, using a designated frequency is a secure wireless means.

Re claims 29, 30, 49, and 50, using a PIN (col. 25, lines 36+) would be a discretionary security policy in that the users would have a choice to set up PINs.

5 Re claims 33 and 51, the RFID reader 104 is further comprised of a display means to display means (col. 12, lines 37+) to display messages at a remote terminal (col. 8, lines 24+).

Re claims 34 and 35, the reader being "guard device" is intended use. Guard device as recited in these claims is not structurally different than the reader device of

10 Beenu.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20

13. Claims 16 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 7,303,120 B2 to Beenu et al.

The teachings of Beenu have been discussed above.

25 Beenu does not explicitly disclose that the communication device is comprised of a display means.

Beenau, however, discloses that the RFID reader 104 is further comprised of a display means to display means (col. 12, lines 37+) to display messages and other indicating means to the user.

It is the Examiner's position that the display means can readily adopted in the
5 RFID fob 102, because some of the information being displayed may be confidential in nature. Such information may be displayed in the user's device rather than reader. Accordingly, the display means can be installed in the fob.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US
10 7,303,120 B2 to Beenau et al. in view of US 7,155,199 B2 (hereinafter "Zalewski").

The teachings of Beenau have been discussed above. Beenua further discloses that the RFID transponder can be a fob, tag, wristwatch, keychain, or other form (col. 4, lines 15-22).

Beenau, however, fails to specifically teach or fairly suggest that the transponder
15 is a cylindrical structure.

Zaleswki teaches RFID transponder which is used in various transactions (col. 1, lines 49-67) wherein the transponder is in the form of cylindrical type (col. 2, line 44).

It is the Examiner's position that a fob in Beenau and a cylindrical type in
Zalewski are only different in their design. Both communicate with the reader, and
20 exchanges information and performs desired transactions. Using one in place of the other would not produce unexpected outcome.

15. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 7,303,120 B2 to Beenau et al. as modified by US 7,155,199 B2 to Zaleswski, and further in view of US 6,745,944 B2 to Dell (hereinafter "Dell").

The teachings of Beenau as modified by Zaleswski have been discussed in
5 paragraph 14 above. Beenau further discloses that the device is comprised of a keyboard (col. 17, line 62) for the user to enter personal information such as PIN.

Beenau and Zaleswski, however, fail to specifically teach or fairly suggest that the device further includes wheel button.

Dell discloses a portable tamper resistance trusted device (see figure 2) which is
10 used in credit transaction – personal identification – comprising a thumb wheel device as an input device (col. 2, lines 45+).

It is the Examiner's position that a keyboard in Beenau and thumb wheel of Dell are design variation element. Both are used in entering user input, and to some users one appears to be more intuitive than the other. Accordingly, one ordinary skill in the art
15 would choose a particular embodiment more appealing to the users. Using one in place of the other would not produce unexpected outcome.

Allowable Subject Matter

16. Claims 7-9, 13-15, 21, 36, and 43 are objected to as being dependent upon a
20 rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter: Claims are directed at a credential communication device and a method of

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verification of credentials. The device and methods as recited in these objected claims are neither disclosed nor suggested by the cited references.

Conclusion

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 8:00 AM to 5:00 PM Monday thru Friday.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (571)273-8300.

15 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

25 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more
30 information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

35 /Ahshik Kim/

Primary Examiner
Art Unit 2876
July 17, 2009

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